

REMARKS

Claims 1-25 remain in the application. The actions taken are in the interest of expediting prosecution and with no intention of surrendering any range of equivalents to which Applicants would otherwise be entitled in view of the prior art. Moreover, the amendment or cancellation of claims herein is without prejudice to pursuing claims of different scope by way of continuing Application. Reconsideration of this application is respectfully requested.

35 U.S.C. § 103

Claims 1-25 stand rejected under 35 U.S.C. §103(a) as being unpatentable by Bridgelall, U.S. Pat. Application No. 2002/0085516 (hereinafter “Bridgelall”) in view of McConnell (U.S. Patent No. 6,970,719, hereinafter McConnell). Applicants’ respectfully traverses this rejection.

It is incumbent upon the Examiner to prove a *prima facie* case of obviousness (MPEP 2142). To establish a *prima facie* case three basic criteria must be met. First, the prior art reference must teach or suggest all the claim limitations. Second, there must be a reasonable expectation of success. Finally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference.

The Examiner states in “Response to Arguments” of the 08/25/2006 Office Action that the main argument made by the Applicant is that neither Bridgelall nor McConnell teach or suggest Applicant’s recited limitation of “*detecting a condition indicative of initiating a communication over a first network and registering with a second network upon detection of the condition.*” Applicant’s agrees with this. The Examiner further states that Bridgelall fails to disclose this claim limitation. However, on page 3, first paragraph of the Office Action, the Examiner still maintains that Bridgelall discloses this limitation. Despite this, Applicant’s will take notice that the Examiner has acknowledged that Bridgelall does not teach the Applicant’s recited limitation.

The Examiner goes on to maintain that McConnell teaches Applicant’s claimed limitation. However, the Examiner acknowledges that McConnell merely teaches registering on the public and private networks **concurrently or simultaneously**. This is NOT what is claimed

by Applicant's as noted in the argument put forth in the previous response and reproduced below. The Examiner attempts to distort the teaching of McConnell by equating powering up the mobile device as equivalent to a condition indicative of initiating communication over a first network. Applicant's again dispute this misinterpretation of McConnell. First, merely powering up the mobile device is not indicative of initiating communication over the first network, but merely registering with the first network. Secondly, upon power up, the mobile device of McConnell registers with BOTH networks simultaneously (as admitted by the Examiner), which is very different from Applicant's claimed limitation of "*detecting a condition indicative of initiating a communication over a first network and registering with a second network upon detection of the condition.*"

To respectfully drive home these points, the arguments put forth previously by Applicant's regarding the differences between the cited references and Applicant's independent claims are included below:

Bridgelall teaches a method for seamless voice/data roaming between a WWAN and a WLAN using an explicit call transfer (ECT) command. In order for seamless voice/data roaming as taught by Bridgelall to function, a voice or data traffic connection must already be in progress (paragraphs 062, 066, 069). In other words, Bridgelall teaches that seamless roaming, where *roaming begins once a WWAN voice connection is in progress and a WLAN network association has already been established* (paragraph 066).

To elaborate, Bridgelall discloses a mobile station able to vertically roam in either direction between two networks (abstract). Figure 11 illustrates the overall processes 1100 for seamless active voice/data roaming between WWAN 1101 and a WLAN 1103. For Seamless Vertical Roaming (SVR) to be accomplished, simultaneous signaling in one network must be feasible between a full traffic connection in the other network (Paragraph 0062). Two different processing states achieve simultaneous GSM/GPRS and WLAN communications, but where the voice traffic connection and signaling processes in either network are interleaved, simultaneous voice and data traffic are not expected on both WLAN and the GSM. *Transitions from one network to another are only possible once the signaling process is complete and the basic connection is already established on the second network* (Paragraph 0062).

As indicated by the Examiner, an outgoing VoIP call from the WLAN radio to a remote party on the WLAN will transition or seamlessly switch over to the WWAN connection when the mobile station detects packet error rates, frequent scale back, or consistent signal degradation (Paragraph 0011). These conditions (i.e. packet error rates, frequent scale back, and consistent signal degradation) are indicative of *the state of the signal* being used and NOT indicative of *initiating a communication* over a wireless network.

As illustrated in Figure 12, the SVR roaming process 1200 *begins while Radio A is already engaged in a voice traffic connection with Party C*. At step 1, an explicit call transfer (ECT) command is issued to the WWAN network so as to initiate transfer of the channel to the gateway that is hosting the WLAN Radio B (Paragraph 0069). At step 2, upon receiving the ECT command, the WWAN checks whether or not the gateway connected to Radio B is registered to the WWAN network and is answering the call (Paragraph 0070). At step 3, Radio B verifies the call identification is from Radio A and immediately signals the gateway to accept the call. The WWAN receives confirmation that the gateway signaled acceptance of the call (Paragraph 0071). Therefore, *an explicit command is issued to initiate transfer of the channel between the WWAN network and the WLAN network as opposed to registering with a second network upon detecting a condition indicative of initiating a communication over a first network*.

Bridgelall thus discloses issuing an explicit call transfer demand to initiate the transfer of a communication between one network to another network when conditions indicative of the condition of the signal are detected. Specifically, Bridgelall does NOT disclose *detecting a condition indicative of initiating a communication over a first network and registering with a second network upon detection of the condition*.

In other words, in Applicants' claims, voice or data communication has not yet been initiated over the first wireless network. Only a condition indicative of initiating communication is detected, which initiates registration with the second network. Since no voice or data communication is yet established, and no registration with a second network has taken place, there can be no roaming yet. Since the entire teachings of Bridgelall occur after roaming has been established, Bridgelall does not teach or suggest Applicant's claims.

McConnell teaches *simultaneously* registering with a private and a public network (Figure 7 and column 18 lines 28-45). McConnell does NOT disclose *detecting a condition indicative of initiating a communication over a first network and registering with a second*

network upon detection of the condition. McConnell, as admitted by the Examiner, is limited to teaching the simultaneous registration on a private and a public network, which is not the same as Applicant's recited limitations. Applicant's recited limitations require detecting a condition indicative of initiating communication in one network before registering or attempting to register with the second network. The teachings of McConnell do not make up for the deficiencies in the teaching of Bridgelall.

Since neither Bridgealall nor McConnell, independently or together, teach each and every element of independent claims 1, 11 and 16, they do not make obvious independent claims 1, 11 and 16. Therefore, Applicants respectfully request that this rejection be withdrawn and that the claims proceed to allowance.

Claims 2-10 depend directly or indirectly from claim 1 and are allowable over the cited art for the same reasons as claim 1.

Claims 12-15 depend directly or indirectly from claim 11 and are allowable over the cited art for the same reasons as claim 11.

Claims 17-25 depend directly or indirectly from claim 16 and are allowable over the cited art for the same reasons as claim 16.

Prior Art

The references cited but not relied upon are believed not to anticipate or make obvious Applicants' invention.

Summary

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Applicants believe that the subject application, as amended, is in condition for allowance. Such action is earnestly solicited by the Applicants.

In the event that the Examiner deems the present application non-allowable, it is requested that the Examiner telephone the Applicant's attorney or agent at the number indicated below so that the prosecution of the present case may be advanced by the clarification of any continuing rejection.

Accordingly, this application is believed to be in proper form for allowance and an early notice of allowance is respectfully requested.

Please charge any fees associated herewith, including extension of time fees, to 502117, Motorola, Inc.

Respectfully submitted,

DATE: 11/02/2006
SEND CORRESPONDENCE TO:
Motorola, Inc.
Law Department
1303 East Algonquin Road
IL01/3rd Floor
Schaumburg, IL 60196
Customer Number: 23330

By: /Kevin D. Wills/
Kevin D. Wills
Attorney of Record
Reg. No.: 43,993
Telephone: 480-732-5364
Fax No.: 480-732-2402
Email: Kevin.Wills@motorola.com